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EXAMINER

REDDICK, MARIE L

ART UNIT PAPER NUMBER

1713

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,509

Applicant(s)

SHIROTA ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/16/03 & 06/23/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-22 is/are rejected.
- 7) ☒ Claim(s) 11, 13, 14 & 18-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 11, 13, 14 and 18-21 are objected to because of the following informalities: In claim 11 @ line 2, "consistin" should read "consisting"; In claim 13 @ line 2, "grou" should read "group"; In claim 14 @ line 2, "vesicle" should read "vehicle"; It is suggested that applicants insert "value" after "Y" and "X" in claims 18-21. For example, in claim 18, "wherein solvent (ii) has a Y value". Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-13 & 15-22 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Murakami(U.S. 4,212,786) or Okuda et al(U.S. 4,829,108) as per reasons set forth in the previous Office Action per paper no. 5, 12/11/02.

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Further, Murakami @ col. 4, lines 43-60 teach that the organic solvents useful in this invention are those having a boiling point of about 100 degrees to about 250 degrees C and capable of effectively dissolving the resins A and B, di- and tri-benzylidene sorbitols and derivatives thereof. Examples of preferred solvents are glycols, ethers of glycols, ether esters of glycols and benzoic acid esters. Examples of glycols are ethylene glycol, diethylene glycol, propylene glycol, hexylene glycols, etc. Examples of ethers of glycols are methyl ethers, ethyl ethers, propyl ethers, butyl ethers and the like of the above-mentioned glycols. Examples of ether esters of glycols are acetates, propionates and the like of the above-mentioned glycol ethers. Exemplary of benzoic acid esters are ethyl benzoate, butyl benzoate, etc. These solvents are used singly or in admixture in an amount of about 25 to about 60 parts by weight, preferably about 30 to about 55 parts by weight, per 100 parts by weight of crayon composition. More specifically, Murakami exemplify compositions which house a colorant, a gelation agent, a resin component and a solvent falling within the scope of (i) and/or (ii). See at least Runs 3, 4, 6 and 11. Further, Okuda et al @ col. 5, lines 3-15 teach with respect to component (E), examples of ethers of glycols are C1-C4 alkyl ethers of C1-C6 glycols such as methyl ethers, ethyl ethers, propyl ethers, butyl ethers and the like of ethylene glycol, diethylene glycol, propylene glycol, hexylene glycol and the like. Examples of ether esters of glycols are C2-C3 fatty acid esters, such as acetates, propionates and the like, of the above glycol ethers. Examples of benzoic acid esters are C2-C4 alkyl esters of benzoic acid, such as ethyl benzoate, butyl benzoate and the like.

Each of Murakami and Okuda et al anticipate the instantly claimed invention with the understanding that the solvent genus per Okuda et al is sufficiently small enough to justify a rejection under 35 USC 102 as provided for under the guise of *In re Schaumann*, 572 F.2d 312, 197 USPQ 5(CCPA 1978).

As to the ability of each of the compositions of patentees to be used on "a wet-surface", i.e., possess "wet-surface" writability, if not taught, this would be expected since the compositions of patentees are essentially the same as and made in essentially the same manner

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as the claimed composition. The onus to show that this, in fact, is not the case is shifted to applicants under the guise of *In re Best et al* (195 USPQ 430).

Even if it turns out that the claimed invention is not anticipated, it would have been obvious to the skilled artisan to extrapolate the solid composition, as claimed, from Murakami and Okuda et al as per such having been within the purview of the general disclosures of Murkami and Okuda et al and with a reasonable expectation of success, absent a clear showing of criticality commensurate in scope with the claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami(U.S. 4,212,786) or Okuda et al(U.S. 4,829,108).

The disclosures of each of Murkami and Okuda et al for what they teach as applied to claims 9-13 and 15-22 as set forth supra. Further, the disclosures of Murakami and Okuda et al differ basically from the claimed invention as per the non-express guidelines to use the colorant as defined per claim 14 in the resin compositions of patentees. However, the interchangeability of one well known colorant for another is a matter of ordinary choice to the skilled artisan and with a reasonable expectation of success, absent some evidence of unusual or unexpected results.

Response to Arguments

8. Applicant's arguments filed June 23, 2003 have been fully considered but they are not persuasive.

Relative to Murakami and Okuda et al—The crux of Counsel's arguments appears to hinge on neither Murakami(D1) or Okuda et al(D2) discloses or suggests use of the specific solvent(s) of the present invention. With all due respect to the opinion of Counsel, at least Runs 3, 4, and 6 of Murakami and col. 5, lines 10-11 of Okuda et al, which house/teach "ethyl benzoate", governed by a solubility parameter of 8.2 as provided for in the Polymer Handbook, Third Ed, J. Brandrup & E. H. Immergut, 1989), is sufficient to meet the limitations of at least solvent (i). Moreover, it is reasonably expected that solvents such as methoxy-butyl acetate and methoxy butanol would meet the limitations provided by the claimed solvents(s) since these solvents possess functional moieties that closely resemble solvents which possess solubility parameters of less than or equal to 8.5, in the absence of the USPTO to have at its disposal, the tools or facilities deemed necessary to make physical determinations of this sort. There is nothing viable on this record diffusing this issue.

As to the comparative Runs relied on by Counsel to establish a showing of criticality for the solvent(s), viz., Comparative Run 7, Counsel is reminded that comparative data of this nature is insufficient to confer patentability under 35 USC 102. Even if the Examiner somehow missed

the boat and the claims are not anticipated, the claims are simply not limited to where any improvement might have been shown. It should be noted that none of the Inventive Runs houses less than two(2) solvents.

Counsel is herein apprised that a future rejection under 35 USC 112, 2nd paragraph, can be precluded by identifying the wt. basis for the content governing the solvent per claim 22. The rejection is not being made at this time as per the outstanding rejections still appear to be valid.

9. Applicant's arguments, see paper no. 9, filed 07/11/03, with respect to the rejections based on Fukuo et al'465 and '910 have been fully considered and are persuasive. The rejections of claims 9-22 based on Fukuo et al has been withdrawn. However, let the record show that, of interest, is that Fukuo et al(U.S. 6,074,465) teach the conventionality of using colorants likened to those of claim 14 in making crayon forming compositions.

Conclusion

10. The prior art to Goto et al(U.S. 6,048,914) is cited as of interest in teaching ink compositions for writing instruments comprising organic solvent(s) having an SP value of 5-15 and is considered merely cumulative to the prior art supra.

11. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.


Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR 
9.17.03